

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte STEVEN W. BURTON

Appeal No. 1996-3112
Application 08/395,170¹

ON BRIEF

Before WILLIAM F. SMITH, LORIN and SPIEGEL, Administrative Patent Judges.

WILLIAM F. SMITH, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal under 35 U.S.C. § 134 from the final rejection of claims 1 through 10, all the claims in the application. Claim 1 is representative of the subject matter on appeal and reads as follows:

1. A method for pulping wood chips comprising the steps of:

¹ Application for patent filed February 27, 1995. According to applicant, this application is a continuation of Application 08/176,299, filed January 3, 1994 (abandoned); which is a continuation of Application 07/944,538, filed September 14, 1992 (abandoned).

(a) feeding the wood chips to a primary refiner zone operating at a temperature of above 145E C and at an energy level of less than about 10 hpd per ton for a time to cause substantive separation of wood fiber comprising said wood chips without causing substantial reduction in the average length of said wood fibers to form pulp comprising said wood fiber having a lignin coating on an outer surface of said fiber;

(b) treating the pulp form [sic, from] step (a) with an enzyme in the substantial absence of treatment chemicals in an amount and for a time sufficient to weaken the strength of the lignin coating to form treated pulp; and

(c) further refining the treated pulp in a second refiner zone operating at an energy of less than about 20 hpd per ton to form a processed pulp comprising wood fiber having a reduced amount of lignin coating wherein the average length of said wood fiber is at least about 80% of the average length of wood fiber in said wood chips.

The references relies upon by the examiner are:

Goheen et al. (Goheen)	4,145,246	Mar. 20, 1979
------------------------	-----------	---------------

Leatham et al. (Leatham), "Energy Savings In Biochemical Pulping," 4th International Conference on Biotechnology in the Pulp and Paper Industry, Raleigh, NC (May 1989).

A reference made of record and discussed by this merits panel is:

Canadian patent (Vaheri)	2,030,186	May 18, 1991
--------------------------	-----------	--------------

Claims 1 through 10 stand rejected under 35 U.S.C. § 103. As evidence of obviousness, the examiner relies upon Goheen and Leatham. We reverse.

DISCUSSION

Viewing Goheen and Leatham apart from appellant's disclosure of the present invention, we find no teaching, suggestion or motivation in the references which would have led one of ordinary skill in the art to combine them in the manner required in order to arrive at the subject matter of claim 1 on appeal. At best, Leatham would have suggested to one of ordinary skill in the art to use a fungus in accordance with that disclosure to pretreat wood chips prior to an initial refining step. We find no teaching or suggestion in Leatham

to use a fungus in an intermediate step between two refining steps as required by claim 1 on appeal. Any suggestion of energy savings which appears in Leatham appears to be premised upon wood chips being treated with a fungus, not refined wood chips, again as required by claim 1 on appeal.

Other Issues

1. Vaheri

This merits panel has been made aware of Vaheri. This reference describes what appears to be the essence of appellant's invention, i.e., the treatment of once refined wood chips with enzymes such as laccase can reduce the power consumption of subsequent refining steps. However, Vaheri does not describe the details of the claims on appeal.

Upon return of the application, the examiner should review Vaheri and other relevant prior art and determine whether the subject matter as a whole of any claim pending would have been obvious to one of ordinary skill in the art.

2. Search

We note that it does not appear that the examiner used any of the available electronic databases in performing his search. Upon return of the application, the examiner should ensure that all appropriate search tools have been employed in determining the patentability of the pending claims.

3. Formal matters

As a reminder to appellant and the examiner, we point to the examiner's comments at the end of the examiner's answer concerning the confusion surrounding whether this application is a continuation application or a continuation-in-part application.

Appeal No. 1996-3112
Application 08/395,170

The decision of the examiner is reversed.

REVERSED

William F. Smith)	
Administrative Patent Judge)	
)	
)	
Hubert C. Lorin)	BOARD OF PATENT
Administrative Patent Judge)	APPEALS AND
)	INTERFERENCES
)	
Carol A. Spiegel)	
Administrative Patent Judge)	

Appeal No. 1996-3112
Application 08/395,170

Richard C. Stewart, II
Champion International Corporation
1 Champion Plaza
Stamford, CT 06921

WFS/cam